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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,420	01/30/2002	Bjarne Egon Ostergaard	PATRADE	4752
7590	02/25/2005		EXAMINER	
James C. Wray Suite 300 1493 Chain Bridge Road McLean, VA 22101				LIN, KELVIN Y
		ART UNIT	PAPER NUMBER	2142

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/058,420	OSTERGAARD, BJARNE EGON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kelvin Lin	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/09/02</u> .	6) <input type="checkbox"/> Other: _____.

## Detailed Action

### ***Claim Rejections - 35 USC § 101***

1. Claims 8-10 rejected under 35 U.S.C. 101 because :

Claims 8-10 are directed to non-statutory subject matter as being drawn to a program per se. Programs per se are not one of the statutory classes of invention. Programs must be tangibly embodied on a computer readable medium and be drawn to a practical application in order to be eligible for patent protection.

2. Enabling Issues:

- How does the email be sent out after stealing without email server information?
- How to allocate the stolen device if the IP address is temporarily assigned?

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. In Claim 8 the phrase "said disagreement" lacks sufficient antecedent basis
4. The above noted problems are not necessarily an exhaustive listing, but a meant to be exemplary of the types of errors present. It is incumbent upon an applicant to ensure that any amendment filed resolves all deficiencies and places the

claims in compliance with 35 USC 112.

5. Appropriate correction is required

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12 are rejected under 35 USC 102(e) as being anticipated by Ronen et al., (US PG Pub No. 2003/0101357).

8. Regarding claim 1, Ronen teaches a method for enabling the tracing of a computer connected to a data network (Ronen, P.3, [0036], I.3-6), said computer having an actual virtual address when connected to said network (Ronen, P.3, [0046], I.5-8), wherein said method comprises storing at least one authorized virtual address (Ronen, P.3, [0046], I.5, p.7, [0110], I.3-7), comparing said actual virtual address with said at least one authorized virtual address (Ronen, P.3, [0048], I.7-8, p.7, [0112], I.2-4), and in case that said actual virtual address is not identical to an authorized virtual address (Ronen, P.6, [0103], I.21-25, p.7, [0112], I.9-15, p.8, [0120], I.1-11),

sending an electronic message to a predetermined virtual address, said electronic message containing said actual virtual address (Ronen, P.9, [0130], I.1-7).

9. Regarding claim 2, Ronen further discloses a method according to claim 1, wherein said data network is the Internet, said virtual address is an IP address (Ronen, P.6, [0096], I.3), and said electronic message is an e-mail, an SMS message, or a voice message, or said data network is a telephone network, said virtual address is a telephone number, and said electronic message is an SMS message or a voice message (Ronen, P.9, [0130], I.2-4) .
10. Regarding claim 3, Ronen further discloses a method according to claim 1, wherein said electronic message is sent without indication thereof to the actual user of the computer (Ronen, P.9, [0130], I.3-4).
11. Regarding claim 4, Ronen further discloses a method according to claim 1, wherein said method comprises generating a unique ID identifying said computer and storing said unique ID in a data memory of said computer, wherein said electronic message also comprises said unique ID (Ronen, P.8, [0120], I.2-4).
12. Regarding claim 5, Ronen further discloses a method according to claim 1, wherein said method further comprises after a predetermined number of start-ups of said computer or after a predetermined time sending an electronic message to a predetermined virtual address, said electronic message containing said actual virtual address (Ronen, P.4, [0062], I.13-18, p.7, [0110], I.1-5, p.9, [0130], I.6)

13. Regarding claim 6, Ronen further discloses a method according to claim 5, wherein said unique ID comprises identification for selected components of said computer (Ronen, P.8, [0120], I.5-7).
14. Regarding claim 7, Ronen further discloses a method according to claim 1, wherein said method further comprises in case of said disagreement, encrypting preselected documents stored on said computer (Ronen, p.1, [0005], I.5-6,P.8, [0129], I.1-4, that means the email is sent out after being encrypted).
15. Claims 8-10 have been rejected under 35 U.S.C. 101.
16. Regarding claim 11, Ronen further discloses a computer program product comprising program code means stored on a computer readable medium for performing the method according to claim 1 when said computer program product is run on a computer (Ronen, P.14, Item 20). .

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to application's disclosure.

- Conklin et al., (US Patent No. 5991881) Network Surveillance System.
- Holden et al. (US Patent No. 6272538) Method and System For Establishing A Security Perimeter In Computer Networks.
- Day et al., (US Patent No. 6728767) Remote Identification of Client And DNS Proxy IP Addresses.
- Nye T., (US PG Pub. No. 2002/015691) Method For Providing An Attribute Bounded Network Of Computers.
- NPL – Gbellovin S., Probable plaintext cryptanalysis of the IP security protocol, Network and Distributed System Security, 1997, Proceedings, IEEE 1997 Symposium 10-11 Feb. 1997, pp. 52-59.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 703-605-1726. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JACK D. HARVEY  
SUPERVISORY PATENT EXAMINER

Kyl  
2/17/05